

### **REMARKS**

Claims 1, 3-47, 49-80, 82-103 and 112-114 are pending and under consideration. Claims 1, 41, 47, 50 and 114 are amended. Claims 112 and 113 are allowed. Claim 112 is currently amended to correct a grammatical oversight. Claims 13, 23-35, 56 and 89 are objected to. Claim 115 was previously cancelled.

### **Rejections Under 35 U.S.C. § 103**

The Examiner's rejection of Claims 1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101 and 103 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,007,066 to Moody ("Moody") in view of U.S. Patent No. 6,609,978 to Paulsen, ("Paulsen") is respectfully traversed for at least the reasons given below.

The present invention discloses a gaming machine wherein the player can win the second game of chance without obtaining a win in the primary game of chance. Any prize achieved in the second game is awarded, again irrespective of what happens in the first game. The second game of chance has the potential, on every play, for achieving a prize award. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game. But whatever happens in the second game is independent of the first game outcome. Additionally, the present invention teaches that the secondary game of chance is a game in which a non-monetary prize can be achieved.

Moody is a poker type wagering game with at least two rows of five cards. Moody does not teach operating a second game of chance "irrespective of any result occurring in a first game of chance" as recited in independent claims 1, 41, 47, 78 and 96, of which Claims 1, 41 and 47 have been amended to further clarify this limitation. Moody's failure to teach this limitation is apparent by the Examiner's lack of argument to the contrary. (See Office Action, pp. 2-3).

In Moody, the player selects none, one or more cards to keep from one row of cards (column 1, lines 35-37). The cards that are kept are duplicated from the first row into all other rows (column 1, lines 37-38). Moody's second game of chance is dependent on an event in the first game of chance: what is held and reproduced. Thus, the second game of chance in Moody is not irrespective of the outcome in said first game of chance. The game of Moody is therefore much different, because what happens in the first game establishes what can and cannot be won in the second game. The additional hands of Moody are *dependent* upon the primary game.

Independent Claims 1, 41, 47, 78 and 96 clearly recite the limitation that the second game is operated irrespective of the initial outcome in the first game, which Moody fails to teach or suggest. Since Applicants' independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner's rejection of Claim 102 under 35 U.S.C. §103 as being unpatentable over Moody in view of Paulsen, in further view of U.S. Patent No. 6,468,156 to Hughes-Baird et al., ("Hughes-Baird") is moot in light of the arguments above. Dependent Claim 102 plainly contains all of the limitations of independent Claim 96. As distinguished above, independent Claim 96 is not obvious in view of any combination of the cited references. Since Claim 96 is in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner's rejection of Claims 14, 36-39, 57, 73-77, 90, 99 and 114 under 35 U.S.C. §103 as being unpatentable over Moody in view of Paulsen, in further view of U.S. Patent No. 6,311,976 to Yoseloff et al., ("Yoseloff") is respectfully traversed for at least the reasons given below.

Yoseloff does not fulfill the deficiencies of Moody and Paulsen, described and distinguished above.

Yoseloff does not teach operating a second game of chance "irrespective of any result occurring in a first game of chance". Yoseloff discloses a wagering game with a first game segment and a second game segment that are operated separately. The second game segment of Yoseloff is "a bonus event or jackpot event" (column 7, lines 53-55). The second game segment is initiated upon a predetermined triggering event such as the appearance of three similar symbols on the reel (column 11, lines 66 – column 12, line 2). The second game segment may not be played at all if the triggering event does not occur in the first segment (column 12, lines 3-5). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach playing the second game segment irrespective of any result occurring in the first game segment since, in Yoseloff, three similar symbols in the first game segment initiates the bonus event.

Independent Claims 36 and 114 and dependent Claims 14, 37-39, 57, 73-77, 90, and 99 all include the limitation that the second game of chance is operated irrespective of any result occurring in a first game of chance distinguishing Applicants' invention over the cited references. As distinguished above, *supra*, independent Claims 1, 36, 47, 78 and 96 are not obvious in view

of any combination of the cited references. Since Applicants' independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner's rejection of Claims 22, 40 and 42-43 under 35 U.S.C. §103 as being unpatentable over Moody in view of Paulsen, in further view of U.S. Patent No. 6,685,563 to Meekins et al., ("Meekins") is respectfully traversed for at least the reasons given below.

Meekins does not fulfill the deficiencies of Moody and Paulsen, described and distinguished above.

Meekins does not teach operating a second game of chance "irrespective of any result occurring in a first game of chance". Meekins is a method of operating a wagering game with a base unit and bonus unit (column 2, lines 45-55). The base unit is played wherein a winning payout increases the player's credits on a credit meter or payout through a coin exit chute (column 4, lines 42-45). The bonus game initiates when the coin or credit threshold exceeds a predetermined value (column 4, lines 42-45). The bonus game is dependent on the result occurring in the base game (column 4, lines 63-64; column 6, lines 30-34). A winning condition in the base game increases the player's coins or credits which in turn advances the player to the predetermined threshold value required for playing the bonus game (column 6, lines 30-34).

In contrast to Applicants foregoing Claims, Meekins does not teach each and every limitation of independent Claims 1, 40 and 41. As distinguished above, independent Claims 1, 40 and 41 are not obvious in view of any combination of the cited references. In addition, dependent Claims 22 and 42-43 contain further limitations that the cited prior art raised in rejection does not teach or suggest as a whole. Since independent Claims 1, 40 and 41 are in condition for allowance, all dependent claims thereon are also in condition for allowance.

#### **Allowable Subject Matter**

Applicants acknowledge the allowability of Claims 112-113. In addition, Applicants acknowledge the objection to Claims 13, 23-35, 56 and 89 as being dependent upon a rejected base claim, but allowable if rewritten in independent form. Applicants suggest however, in view of this Response, that these Claims should be allowable without the need for a re-write. The Applicants respectfully request reconsideration of the Examiner's objections.

Allowance of this application is respectfully requested.

Appl. No. 10/051,316  
Reply to Office Action of March 26, 2004

June 30, 2004

BANIAK PINE & GANNON  
150 N. Wacker Drive, Suite 1200  
Chicago, Illinois 60606  
(312) 673-0360  
(312) 673-0361 facsimile

Respectfully submitted,

A handwritten signature in black ink, appearing to read "M. Baniak", written over a horizontal line.

Michael H. Baniak  
Registration No. 30,608  
Allison M. Dudley  
Registration No. 50,545  
Attorneys for Applicants